



## ATTACHMENT A

### Remarks

In response to the Office Action mailed on November 18, 2004, Applicant exercises the option of filing a response under 35 CFR 1.111.

Turning to the Office Action itself, claims 1-5 have been rejected under 35 U.S.C. § 102(b) as being anticipated by the Garthwaite reference. This rejection is respectfully traversed although claim 1 has been amended to even more clearly define over this reference.

The Garthwaite reference discloses a computer command and pointing device (mouse) that attaches directly to a computer or keyboard without the need for external electrical cables. As shown in Figure 1, and described in column 3, lines 31-36, computer 1 of Figure 1 comprises a computer housing 2, a computer keyboard 3 and a display screen 4, and the computer command and pointing apparatus 10 may be directly coupled to the computer keyboard 3 or the computer housing 2.

It is respectfully submitted that it is clear that the keyboard 3 is an integral part of computer 1 and not a remote computer has claimed in claim 1.

Moreover, it is not seen that the housing of the keyboard defines a "non-integral personal computer keyboard" in that the keyboard is integrated with the remainder of the computer. Thus, it is respectfully submitted that claim 1 defines over the Garthwaite reference for at least these reasons.

With respect to claims 2 to 5, Garthwaite discloses a mounting arrangement for the computer command and pointing device 10 which includes a recess 50 having a pair of flanges 54 that are spaced apart to receive tabs 40 of release latches 32 so as to mechanically couple the device 10 to the computer keyboard 3.

It is respectfully submitted that the mounting arrangement of Garthwaite is not a plurality of surfaces defining a cradle cavity into which connector is disposed and wherein the cradle cavity is shaped so that the device fits in the

cavity such that at least one surface of the device is exposed. In this regard, it is respectfully submitted that there is no cradling of the mouse 10 in Garthwaite, nor any provision of a cradle cavity in which the mouse fits. In Garthwaite, the mouse is located outwardly from the recess 50 and does not fit therein, and the only interaction is between the tabs and flanges as discussed above. With respect to defendant claim 5, it is contended in the Office Action that this claim is met by Figure 7C, "when said device 10 is positioned perpendicularly to the supporting surface, (i.e., at the 90° angle to the top surface of the keyboard)." This contention is not understood. Figure 7C shows the mouse positioned at 45° and there is no disclosure in Garthwaite that the mouse 10 would be flush with the housing of the keyboard in any position of the mouse.

Further with respect to this issue, a new claim 30 has been added which depends from claim 1 and recites that the housing includes a cradle cavity in which the device nests and which includes a support surface on which a major surface of the device rests. Again, given the actual teachings of Garthwaite, this feature is simply not disclosed in the Garthwaite reference.

Claims 17, 20 and 21 have been rejected under 35 U.S.C. 102(e) as being "anticipated by" the Kikinis reference. This rejection is respectfully traversed.

The Kikinis reference has been relied on in several previous Office Actions. In the current rejection, reliance is placed on Figure 20 and keyboard 151. However, it is respectfully submitted that the keyboard illustrated in Figure 20 contains none of the elements recited in claims 17 and 20. For example, the connector 153 to which reference is made is illustrated as being external to the keyboard, not within the keyboard as recited in these claims. In this regard, contrary to the contention in the Office Action, the plug 20 must be read as the connector for connecting the keyboard to PDA 10, and plug 20 is clearly not disposed within the keyboard. Moreover, nothing inside of the keyboard 151 constitutes a connector which receives a connector of the PDA 10, and it is respectfully submitted that the attempt in Office Action to read these claims on

the Kikinis reference is clearly a distortion of what actually is disclosed by the reference, i.e., a simple cable and plug and socket connection between keyboards 151 and PDA 20.

With respect to defendant claim 21, it is respectfully submitted that this claim further defines over the Kikinis reference. In particular, it is respectfully submitted that the simple cable and plug connection of the reference does not provide a flush mounting of at least one of a top surface and a bottom surface of the PDA flush with a corresponding surface of the keyboard housing.

Further, new claim 29 has been added which depends from claim 20 and, similarly to claim 30, recites that housing includes a cradle cavity in which the device nests and which includes a support surface on which a major surface of the device rests. Again this feature is simply not disclosed by the Kikinis reference nor the Garthwaite reference.

Claims 6-11 and 13-16 are rejected under 35 U.S.C. § 103(a) as being "unpatentable over" Garthwaite in view of Kikinis. This rejection is respectfully traversed.

It is respectfully submitted that these claims are patentable for at least the reasons set forth above in support of the claims parent thereto. Further, a number of these claims are also separately patentable.

For example, with respect to claim 16, it is noted that device 10 of Kikinis is inserted into a telephone handset. In contrast, in claim 16, the device is a telephone handset that is inserted into a cavity of a non-integral keyboard. It appears that, in the Office Action, the telephone handset is being read as two different elements of the claims, viz., the device itself and the keyboard. In order for this interpretation to be correct, the handset (device) would have to be insertable in the handset (non-integral keyboard). In other words, the handset would have to be insertable into itself, which is clearly not possible. Thus, it is respectfully submitted that claim 16 is separately patentable.

Regarding claim 14, this claim further recites that the “device is a touch screen device including at least one changeable virtual key that interacts with the computer.” As defined in the specification, the changeable virtual keys, in effect, extend the capabilities of the keyboard when the device is docked to the keyboard, and such keys are programmed in accordance with computer software applications running on a computer and thus change in accordance with the active application on the computer. Thus, as claimed, the changeable virtual key interacts with the host computer. In contrast, the softkey disclosed in Kikinis does not interact with the host computer but rather is a softkey operable on the PDA itself. Thus, it is respectfully submitted that claim 14 also patentably defines over the references cited.

Finally, claim 18, which has been objected to but has provisionally been indicated to be allowable if rewritten in independent form, has been rewritten in independent form and thus should now be allowable.

In summary, for the reasons set forth above, withdrawal of the current rejections and allowance of the application in its present form are respectfully solicited.

**END REMARKS**